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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/552,302      | 07/26/2006  | Chi Vu               | A 1 9 4 US 002      | 1885             |

7590 12/31/2008  
Biogen Idec Inc  
Patent and Trademark Coordinator  
14 Cambridge Center  
Cambridge, MA 02142

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| EXAMINER |
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KIFLE, BRUCK

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| ART UNIT | PAPER NUMBER |
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1624

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| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

12/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                  |  |
|------------------------------|--------------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/552,302 | <b>Applicant(s)</b><br>VU ET AL. |  |
|                              | <b>Examiner</b><br>Bruck Kifle       | <b>Art Unit</b><br>1624          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 2-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

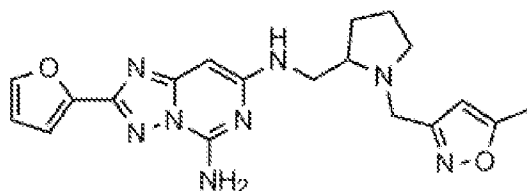
- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/09/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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***Election/Restrictions***

Applicant's election of the species 2-furan-2-yl-N7-[1-(5-methyl-isoxazol-3-ylmethyl)-pyrrolidin-2-ylmethyl]-[1,2,4]triazolo[1,5-c]pyrimidine-5,7-diamine in the reply filed on 10/07/08 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The elected species has the following structural formula



The elected compound was not found and the search was expanded to embrace compounds of formula (I) wherein A is furan, B is N along with the full scope of the remaining variables.

It is unclear how this compound is a compound of the instant claims. R<sup>1</sup> in claim 1 does not permit a substituent.

Claims 2-42 are withdrawn from consideration because art was found (see MPEP 803.02.)

Applicants are advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth and fifth paragraph, where is stated:

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type

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claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**" (Emphasis added).

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is found that anticipates or renders obvious the Markush-type claim with respect to a non-elected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

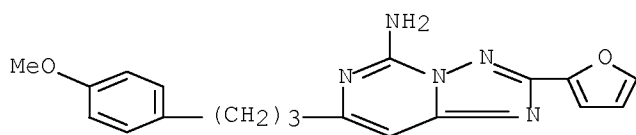
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Matasi et al. (US 7,041,666). The claim reads on the compound 77 in column 45 of the reference. This compound is depicted below.

RN 540751-78-8 CAPLUS

CN [1,2,4]Triazolo[1,5-c]pyrimidin-5-amine,  
2-(2-furanyl)-7-[3-(4-methoxyphenyl)propyl]- (CA INDEX NAME)



***Claim Rejections - 35 USC § 112***

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i) The term “heteroaryl” is indefinite because it is not known how many atoms are present, how many and what kind of heteroatoms are involved, what size ring is intended and how many rings are present.

ii) Similarly, the terms “heterocycloalkyl,” “heterocycloalkenyl,” “heteroaralkyl” and “heterocyclyl” are indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended.

iii) In the definitions of R' and R,” urea and thiourea are present. These are compounds and not substituents and it is unclear what Applicants here intend.

iv) When two adjacent R' groups can join to form a 4 to 8 membered optionally substituted cyclic moiety, it is unclear which atoms form the cyclic moiety. Also, the term “substituted” without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not.

Applicants are urgently requested to point to the excluded compounds in the prior art if the provisos are present to avoid prior art rejections because the disclosure of these excluded compounds is material to the examination of this application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is 571-272-0668. The examiner can normally be reached on Mondays-Fridays from 8:30 AM -6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bruck Kifle/  
Primary Examiner  
Art Unit 1624

BK  
December 24, 2008